

REMARKS

This invention provides for *inter alia*, to a process dispensing a paint, printing ink or pigment paste, an aqueous pigment concentrate and to coating system ~~which involve or~~ contain a copolymer based upon oxyalkyleneglycol-alkylene ethers and unsaturated dicarboxylic acid derivatives.

It is believed that no fee is required for the consideration of this Amendment. If, however, a fee is required, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account 50-0320.

Applicants affirm their election of the invention of Group II, claims 10 to 19 and 23, as the elected invention. Applicants respectfully traverse the Restriction Requirement and request its modification and/or withdrawal. Applicants respectfully submit that the Requirement is not proper since the searches for the inventions would overlap as all the inventions relate to copolymers based upon oxyalkyleneglycol-alkylene ethers and unsaturated dicarboxylic acid derivatives. Accordingly, searching all the inventions would not constitute an undue burden to the Office. Further, it is urged that, if followed, the Restriction Requirement is contrary to the public policy.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP §803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application "[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions." *Id.*

The inventions of Group I, Group II and Group III all involve a copolymer based on oxyalkyleneglycol-alkenyl ethers and unsaturated dicarboxylic derivatives. As such, the search for using the same to disperse a pigment or a pigment aqueous concentrate would overlap as well as a method directed to improving a paint to weathering. In fact, one would find it desirable to search all these areas in order to conduct a complete search. Accordingly, as the searches overlap, searching the invention contained in Group I, Group II and Group III would not constitute an undue burden.

Further, it is respectfully urged that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicants as well as the public. The cost of prosecuting and maintaining these patents is unreasonable in view of the fact that the groups are so closely

related. Further, the public is inconvenienced, as they will not know whether or not Applicants will file a divisional application to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent application.

Accordingly, in view of the foregoing, reconsideration and modification or withdrawal of this restriction requirement are requested.

A new Abstract is added.

Claims 10 to 19 and 23 stand rejected under 35 USC §112, second paragraph, for allegedly being indefinite because the Examiner is unsure what is being claimed. Specifically, the rejection argues that the "variable X includes a group with a variable lm , which is not identified anywhere in the claims" and the expression:

$-NHR^2$ and/or $-NH_2$, where $R^2 = R^1$ or $-CO-NH_2$ and also $-Q^1N-Q^2-NQ^3Q^4...$
 Q^3 and Q^4 are aliphatic and/or alicyclic alkyl radicals

is unclear. Office Action at 5 and 6. As the variable lm is defined in the claims and the expression "and also: is clear when read in view of the indentations used in the claim, it is urged that the claims are not indefinite. Accordingly, withdrawal of this rejection is requested and a search of the invention be undertaken by the Office.

The relevant section in claim 10 which defines the variable lm is as follows:



where

$R^1 =$ is H, an aliphatic hydrocarbon radical;

a cycloaliphatic hydrocarbon;

an aryl radical which is unsubstituted or substituted.

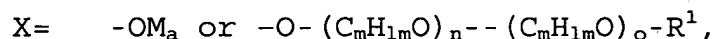
$l =$ 1 or 2,

$m =$ 2 to 18,

the index on the hydrogen atom being formed by the product of l and m , and

(claim 10) (emphasis added). As can be seen, l is an interger 1 or 2 and the variable " lm " is the product of $l \cdot m$; e.g., when l is 2 and m is 2, lm would be 4. In view of the foregoing, it is agreed that the variable " lm " is defined in the claims and would be understood by one skilled in this art.

With regard to the second issue, Applicants urged that the definition of X is not confusing when the definition is read in its entirety. X is defined in claim 10 as follows.



where

$R^1 =$ is H, an aliphatic hydrocarbon radical;

a cycloaliphatic hydrocarbon;

an aryl radical which is unsubstituted or substituted.

$l = 1$ or 2 ,

$m = 2$ to 18 ,

the index on the hydrogen atom being formed by the product of l and m , and

$n = 0$ to 100 , and

$o = 0$ to 100 ,

$\times \Rightarrow$ $-NHR^2$ and/or NR^2_2 where
 $R^2 = R^1$ or $-CO-NH_2$ and also

$-Q^1N-Q^2-NQ^3Q^4$, where

Q^1 is a hydrogen atom or a monovalent hydrocarbon radical;

Q^2 is a divalent alkylene radical;

Q^3 and Q^4 are aliphatic and/or alicyclic alkyl radicals, and

unoxidized or oxidized to $-Q^1N-Q^2-N^{(+)}O^{(-)}Q^3Q^4$,

Hence, it is clear from the orientation in the claim that the "and/or" in

$-NHR^2$ and/or $-NR^2_2$ where
 $R^2 = R^1$ or $-CO-NH_2$ and also

refers to the fact that X may be NHR^2 ^Xand/or $-\text{NR}^2$, and that R^2 is defined as R^1 or $-\text{CO}-\text{NH}_2$. The words "and also" modify the final item in the series for X, i.e., when X is $\text{Q}^1\text{N}-\text{Q}^2-\text{NQ}^2\text{Q}^4$. In view of this, it is urged that one skilled in the art would understand the meaning behind this expression.

In order to provide further evidence that one skill in the art would be accustomed to this formula in defining X, the Examiner's attention is respectfully directed to U.S. Patent 5,798,425, which is cited and discussed in the paragraphs bridging pages 3 and 4 of the present specification. In claim 1 (col. 15, lines 23 to 25) X is defined in a similar manner. Accordingly, it is urged that one skilled in the art would understand the expression and withdrawal of the rejection is requested.

As the claim is definite for the reasons provided above, it is requested that the Examiner search the invention (of numbered paragraph 10 in the Office Action).

Favorable action is earnestly solicited.

Respectfully submitted,

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